

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

POWER INTEGRATIONS, INC., a Delaware  
corporation,

Plaintiff,

v.

FAIRCHILD SEMICONDUCTOR  
INTERNATIONAL, INC., a Delaware  
corporation, and FAIRCHILD  
SEMICONDUCTOR CORPORATION,  
a Delaware corporation,

Defendants.

**REDACTED PUBLIC VERSION**

C.A. No. 04-1371-JJF

**DEFENDANTS' FIRST MOTION TO COMPEL**

ASHBY & GEDDES  
Steven J. Balick (I.D. 2114)  
John G. Day (I.D. 2403) .  
222 Delaware Avenue, 17<sup>th</sup> Floor  
P.O. Box 1150  
Wilmington, DE 19899  
(302) 654-1888

*Attorneys for Defendants*  
**FAIRCHILD SEMICONDUCTOR  
INTERNATIONAL, INC. and FAIRCHILD  
SEMICONDUCTOR CORP.**

*Of Counsel:*

ORRICK, HERRINGTON & SUTCLIFFE LLP  
G. Hopkins Guy, III (#124811)  
Bas de Blank (#191487)  
1000 Marsh Road  
Menlo Park, CA 94025  
(650) 614-7400

Dated: August 10, 2005

Defendants Fairchild Semiconductor International, Inc. and Fairchild Semiconductor Corp. (collectively, "Fairchild") hereby move for an order compelling Plaintiff Power Integrations, Inc. ("PI") to provide full and accurate responses to Fairchild's interrogatories.

Since PI failed to provide Fairchild with any notice prior to filing suit, on the first day permitted (January 24, 2005) Fairchild served interrogatories seeking basic information such as the dates of conception and reduction to practice of the asserted claims and the terms for which PI has previously licensed the asserted patents. Rather than provide a narrative response with this information, PI hid behind Federal Rule of Civil Procedure 33(d) and identified over 19,000 pages of documents. Upon review, it quickly became apparent that these documents were largely irrelevant, but when Fairchild sought additional information, PI refused.

Since PI's responses do not provide Fairchild with the discovery to which it is entitled, Fairchild moves to compel a full narrative response to interrogatory nos. 7-9, 12, 14-17, 19, 21, 23-24, and 26-27.<sup>1</sup> A copy of Fairchild's interrogatories, PI's responses, and PI's supplemental responses are attached as Exhibits A, B, and C, respectively.

Rule 33(d) is only available if (i) the burden of deriving the response is substantially the same for both parties and (ii) the responding party identifies the specific documents (iii) from which responsive information can be derived:

Where the answer to an interrogatory may be derived or ascertained from the business records of the party upon whom it has been served or from an examination, audit or inspection of such business records, including a compilation, abstract or summary thereof, and the burden of deriving or ascertaining the answer is substantially the same for the party serving the interrogatory as for the party served, it is a sufficient answer to such interrogatory to specify the records from which the answer may be derived or ascertained and to afford the party serving the interrogatory reasonable opportunity to examine, audit or inspect such records and to make copies, compilations, abstracts or summaries. A specification shall be in sufficient detail to permit the interrogating party to locate and to identify, as readily as can the party served, the records from which the answer may be ascertained.

Fed. R. Civ. P. 33(d). PI's responses are inadequate since PI fails to comply with Rule 33(d).

**A. The burden on Fairchild to derive responsive information is much greater than the burden on PI.**

In response to Fairchild's First Set of Interrogatories, PI has identified 19,467 pages that

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<sup>1</sup> Fairchild lacks space to address each disputed interrogatory individually within the four page limit of a motion to compel, but is prepared to detail the deficiencies in each interrogatory response should the Court allow.

are allegedly responsive to 15 different interrogatories. Many of these pages are totally irrelevant. For instance, interrogatory no. 8 asks PI to describe the circumstances surrounding the invention of each asserted claim, including specifying the dates of conception and reduction to practice.<sup>2</sup> In response, PI identified 2,002 pages of documents, many of which postdate the filing of the asserted patents. Documents generated years after the asserted patents were filed are not responsive. The burden on Fairchild to wade through such chaff on the chance that relevant documents were included is much greater than the burden on PI to provide a narrative response.

PI's response to interrogatory no. 9 is another example of PI's abuse of Rule 33(d). That interrogatory sought, in part, the identity of the person who made PI aware of the accused Fairchild devices and the dates of such occurrences. This discovery is relevant to Fairchild's claim of laches. In its initial response, PI referred to

The parties met and conferred and Fairchild requested that PI supplement its response to identify Exh. H. Indeed, PI sent Fairchild a sternly worded letter stating that the identification of such witnesses is required by the Federal Rules. Exh. I. When PI supplemented its responses, however, rather than name as it had agreed to do, PI simply identified 6,042 pages of documents and claimed that the name was contained somewhere in these pages. Fairchild's effort to review these over 6,000 pages clearly dwarfs the effort required by PI to honor its earlier commitment and provide the names that PI has in mind.

**B. PI has not sufficiently identified the allegedly responsive documents.**

While PI purports to rely upon the production of documents, PI has repeatedly asserted that its identification of documents is incomplete and that it may rely upon other unidentified documents. *See*, Exhs. C, General Objection No. 12, and F. While cumulative documents need not be identified, PI must identify by specific production number documents sufficient for

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<sup>2</sup> In its initial response, PI provided an incomplete narrative that set forth dates *before* which PI's claims were allegedly conceived and reduced to practice. Obviously, this open-ended range is inadequate as it does not allow Fairchild to determine what references were prior to PI's alleged invention. The parties met and conferred and PI agreed to supplement its response to indicate that the inventions were allegedly conceived and reduced to practice *after* the dates provided. Exhs. D and J. Instead of doing that, however, in its supplemental response PI simply referred Fairchild to 2,002 pages of largely irrelevant documents. Exh. C.

Fairchild to derive a complete response. PI cannot hide its contentions behind Rule 33(d), only to ambush Fairchild later at trial. If PI cannot identify the specific documents from which Fairchild can derive all of the responsive information, PI must provide a narrative response.

In many cases the responsive information simply does not exist in the documents identified by PI. For instance, interrogatory no. 26 seeks details concerning licenses of the PI patents. Such discovery is relevant to at least the issue of what constitutes a reasonable royalty. In response, PI states

Instead, PI refers Fairchild to 892 pages of documents. These documents,  
however, do not include  
Indeed, they do not even include  
If PI intends to rely upon Rule 33(d), it must identify  
If PI cannot or will not do so, it must provide a narrative  
response

**C. Fairchild is unable to derive complete responses from PI's documents.**

Some of Fairchild interrogatories seek PI's contentions. Rather than respond, PI relied upon the production of unidentified documents. Exh. B. While Fairchild was skeptical that it would be able to derive information about PI's contentions from such documents, Fairchild told PI that it would give PI the benefit of the doubt and review whatever specific documents were identified by PI. Exhs. D, E and G. PI delayed until June 30, 2005 before identifying a single responsive document for any interrogatory. When PI finally identified the documents upon which it was relying, Fairchild's fears were confirmed. It is impossible for Fairchild to derive PI contentions – basically, how PI views the evidence – from the documents identified by PI:

Although defendants' interrogatory requests have now been voluntarily modified, even originally the interrogatories were a mixture of contention interrogatories and requests for statements of fact. These type of interrogatories do not lend themselves to answer by use of Rule 33(d). For this reason, plaintiff's reliance on Rule 33(d) is misplaced.

*U.S. Sec. and Exchange Comm'n v. Elfindopan S.A.*, 206 F.R.D. 574, 577 (M.D. N.C. 2002).

Moreover, many of the interrogatories propounded by Fairchild seek information on a claim by claim basis. In response, however, PI refers to undifferentiated sets of documents.

Thus, it is impossible for Fairchild to determine the specific claim for which each document is allegedly responsive. For instance, interrogatory no. 12 asks PI to identify for each asserted claim any secondary indicia of non-obviousness. In response, PI refers Fairchild to 4,821 pages of documents. Even were these documents relevant to the issue of non-obviousness (by and large, they are not), there is no indication as to which claim PI believes the documents relate.

PI's gamesmanship has gone on long enough. Fairchild requires discovery from PI to prepare its case. PI should be compelled to provide a full narrative response to interrogatory nos. 7-9, 12, 14-17, 19, 21, 23-24, and 26-27 and be precluded from later relying on information responsive to those interrogatories that was not disclosed.

ASHBY & GEDDES

*/s/ John G. Day*

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Steven J. Balick (I.D. 2114)  
John G. Day (I.D. 2403)  
222 Delaware Avenue, 17<sup>th</sup> Floor  
P.O. Box 1150  
Wilmington, DE 19899  
(302) 654-1888

*Attorneys for Defendants*  
*FAIRCHILD SEMICONDUCTOR*  
*INTERNATIONAL, INC. and FAIRCHILD*  
*SEMICONDUCTOR CORP.*

*Of Counsel:*

ORRICK, HERRINGTON & SUTCLIFFE LLP  
G. Hopkins Guy, III (#124811)  
Bas de Blank (#191487)  
1000 Marsh Road  
Menlo Park, CA 94025  
(650) 614-7400  
Dated: August 5, 2005

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

POWER INTEGRATIONS, INC., a Delaware  
corporation,

Plaintiff,

v.

FAIRCHILD SEMICONDUCTOR  
INTERNATIONAL, INC., a Delaware  
corporation, and FAIRCHILD  
SEMICONDUCTOR CORPORATION,  
a Delaware corporation,

Defendants.

C.A. No. 04-1371-JJF

**ORDER RE DEFENDANTS' FIRST MOTION TO COMPEL**

Having considered defendants Fairchild Semiconductor International, Inc. and Fairchild Semiconductor Corp.'s (collectively, "Fairchild") First Motion to Compel, the supporting and opposing papers, the pleadings and papers on file with the Court, the arguments of counsel, and good cause appearing therefore,

IT IS HEREBY ORDERED that Fairchild's motion is GRANTED:

1. PI shall provide a full narrative response to interrogatory nos. nos. 7-9, 12, 14-17, 19, 21, 23-24, and 26-27 within 10 days of the date of this Order; and,
2. Power Integrations shall be precluded relying on information responsive to interrogatory. nos. 7-9, 12, 14-17, 19, 21, 23-24, and 26-27 that is not set forth in that narrative response.

**IT IS SO ORDERED** this \_\_\_\_\_ day of \_\_\_\_\_, 2005.

\_\_\_\_\_  
UNITED STATES DISTRICT JUDGE

**CERTIFICATE OF SERVICE**

I hereby certify that on the 10<sup>th</sup> day of August, 2005, the attached **REDACTED**  
**PUBLIC VERSION OF DEFENDANTS' FIRST MOTION TO COMPEL** was served upon  
the below-named counsel of record at the address and in the manner indicated:

William J. Marsden, Jr., Esquire  
Fish & Richardson P.C.  
919 N. Market Street  
Suite 1100  
P.O. Box 1114  
Wilmington, DE 19899

HAND DELIVERY

Frank E. Scherkenbach, Esquire  
Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804

VIA FEDERAL EXPRESS

Michael Kane, Esquire  
Fish & Richardson P.C.  
60 South Sixth Street  
3300 Dain Rauscher Plaza  
Minneapolis, MN 55402

VIA FEDERAL EXPRESS

Howard G. Pollack, Esquire  
Fish & Richardson P.C.  
500 Arguello Street, Suite 500  
Redwood City, CA 94063

VIA FEDERAL EXPRESS

*/s/ John G. Day*

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John G. Day